

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended, is respectfully requested.

Claims 1-15, 17-19, 21-23, and 25-34 are presently active in this case. Claims 16, 20, and 24 were previously canceled without prejudice or disclaimer.

In the outstanding Official Action, Claims 1-15, 17-19, 21-23, and 25-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shoda et al. (U.S. Patent No. 7,096,268, Shoda) in view of the “iTunes software product, as disclosed in both Robbin (U.S. Patent 6,731,312) and the iBasics references: ‘Encode, Organize Radio and Play’ [part 1] and ‘burning CDs’ [part2].”

In the Office Action, Shoda is relied on as the primary reference and the assertion that the “iTunes software product” is the same in both Robbin (U.S. Patent 6,731,312) and the iBasics references: ‘Encode, Organize Radio and Play’ [part 1] and ‘burning CDs’ [part2]” is seemingly relied on as somehow creating a single secondary “iTunes software product” reference.

Apparently realizing that nothing in either Robbin or the “iBasics references” actually teach that the graphic user software taught by Robbin is identical to the graphic interface simply noted as being produced by unidentified “iTunes” software used to import songs from a CD to a designated music folder location as illustrated by the “importing” and “Advanced” screen shots on the third page of the part 1 description (“Encode, Organize, Radio, and Play”) of the “iBasics references,” the outstanding Action presents an undocumented conclusion at the bottom of page 2 that “the combination of the Robbin patent with the iBasics references should be self-evident, as all the references are describing various aspects of the same software product.” In this regard, the Robbins patent does not reference “iTunes” and none of the references indicate a version number as to any “iTunes” product referenced. Such an

undocumented conclusion based upon PTO assumptions does not meet the minimum production of “substantial evidence” that required by the PTO reviewing court.

In this regard, the PTO reviewing court has noted more than once that the PTO falls under the Administrative Procedure Act that requires the PTO to provide “substantial evidence,” not mere unsubstantiated opinions and conclusions. *See, e.g., In re Lee*, 217 F.3d 1365, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) as follows:

Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies. *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). Thus on appeal we review a PTO Board's findings and conclusions in accordance with the following criteria:

5 U.S.C. §706(2) The reviewing court shall—

(2) hold unlawful and set aside agency actions, findings, and conclusions found to be—

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

* * * *

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute;

For judicial review to be meaningfully achieved within these strictures, the agency tribunal must present a full and reasoned explanation of its decision. The agency tribunal must set forth its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the found facts. The Court has often explained:

The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of “reasoned decision making.” Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

Further note the decision of *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation,

unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”).

The outstanding Action then suggests (at the top of page 3) that even though the stated rejection is that Claims 1-15, 17-19, 21-23, and 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoda et al. (U.S. Patent No. 7,096,268, Shoda) in view of the “iTunes software product, as disclosed in both Robbin (U.S. Patent 6,731,312) and the iBasics references,” this statement can be revised into an implied new ground of rejection of Claims 1-15, 17-19, 21-23, and 25-34 under 35 U.S.C. 103(a) as being unpatentable over Shoda in view of Robbin and the “iBasics references.” The rationale offered for this rejection modification apparently being the unsubstantiated theory that teachings in Robbin and the “iBasics references” are interchangeable because each of them teach improving performance of media playing software and somehow evidencing that such teachings were all part of the ordinary capabilities of a person of ordinary skill in the art with reference to MPEP § 2141 and the recent *KSR* Supreme Court decision.

However, to whatever extent that Robbin teaches a media **player** interface and the “iBasics references” also are concerned with using such an interface, the rationale offered in the outstanding Action has misinterpreted MPEP § 2141 and the recent *KSR* Supreme Court decision as suggesting that all the PTO need do is find teachings of software interfaces and then simply presume that the artisan can interchange interface teachings at will without supplying any reasonable basis that would suggest to the artisan any some reason to make such interchanges. This rationale is contrary to the requirement stated in MPEP §2141 for the clear articulation of reasoning with some rational underpinning to support the legal conclusion of obviousness as follows:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir.

2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

Furthermore, the PTO itself prohibits presentations of inferential rejections like this. See MPEP 706.02 (j) noting that "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply" (emphasis added). Accordingly, withdrawal of the improperly presented implied rejection of Claims 1-15, 17-19, 21-23, and 25-34 under 35 U.S.C. 103(a) as being unpatentable over Shoda in view of Robbin and the "iBasics references" is respectfully submitted to be in order.

Returning to the actually stated rejection of Claims 1-15, 17-19, 21-23, and 25-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shoda in view of the "iTunes software product, as disclosed in both Robbin and the iBasics references, this improper rejection is traversed as follows.

First, and as noted above relative to the *Lee* decision, the PTO "must present a full and reasoned explanation of its decision" in terms of setting forth "its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the found facts." The PTO once again fails to present "a full and reasoned explanation of its decision" that the discussions in col. 8, lines 23-55, reasonably teach the "determining unit" (independent Claims 1 and 29) and determining step (independent Claims 3, 18, and 31) as to determining whether a track was previously recorded on the storage unit of the apparatus or not. Also again lacking is any explanation as to how col. 9, lines 23-50, reasonably teach the "display control unit" (independent Claims 1 and 29), controlling display step (independent Claims 3 and 31) and the required "automatically selecting" of independent Claim 18.

More importantly, and as noted in the last two responses, the relied upon discussions in columns 8 and 9 of Shoda referred to in the outstanding Actions are concerned with

content that has already been stored on the apparatus (1) in internal data storage unit (15), or is **automatically downloaded** based on the instruction (30). The user is not prompted by a display as to whether any content has not been previously recorded. Instead, Shoda merely describes downloading content based upon an instruction from a user (no indication is given as to how the content is searched for or selected), and the only items that are described in Shoda as being displayed are items that have already been stored in the apparatus (1). Note, for example, that each item displayed in Figure 7 and discussed in the charts of Figures 8-10 indicates the rights associated with that content (i.e. whether or not playback is available, or whether or not check-out is available). Further note that Shoda teaches the downloading of those rights (namely, billing information 43 that includes use condition, price, and decryption key for each content as stated in column 6, lines 26-28) *at the same time the content itself is downloaded*. See Figure 3a and corresponding discussion. The depictions in Figure 7 all include information from copyright management table (16), which is described as storing “copyright management information for each content that is stored in the internal data storage unit 15.” (Col. 7, lines 51-57.) No display is provided for content that was not previously recorded, in which case there would be no icons 66-71 next to the title.

Thus, it is once again submitted that the relied on portions of Shoda do not teach or suggest a display control unit for controlling display of information on the display regarding a track that was not previously recorded, wherein the display control unit initially indicates the track that was not previously recorded as being selected for recording, as recited by independent Claims 1 and 29, for example. Applicants also again submit that this portion of Shoda does not teach or suggest a display control step for controlling display of information on a display of the apparatus regarding a track that was not previously recorded to the apparatus, wherein the track that was not previously recorded is initially indicated as being selected for recording, as recited by independent Claims 3 and 31, for example, or the

independent Claim 18 required “automatically selecting portion or portions of the contents of the first recording medium for recording that do not have recorded history information present in said apparatus.”

Applicants further submit that this relied upon portion of Shoda (cols. 8 and 9) does not teach or suggest code for a display control step for controlling display of information on a display of the apparatus regarding a track that was not previously recorded to the apparatus, wherein the track that was not previously recorded is initially indicated as being selected for recording, as recited by independent Claims 4 and 33, for example, or the independent Claim 22 required code “automatically select portion or portions of the contents of the first recording medium for recording that do not have recorded history information present in said apparatus.”

Independent Claim 14 is an apparatus claim including means plus function recitals similar to the above noted steps of independent Claim 18 and code of independent Claim 22. Besides requiring that selecting means “automatically selects a portion or portions of the contents of the first recording medium for recording that do not have recorded history information present,” this independent claim recites other means plus function limitations not properly analyzed as required by the case law. See, for example, *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) as follows:

In addition, the [PTO] never construed the scope of the structures disclosed in the specification for the claimed "receiving means," nor did the [PTO] expressly find that the "receiving means" disclosed in the specification was structurally equivalent to that embodied in [the reference]. Moreover, the [PTO] also failed to define the exact function of the receiving means, as well as to find that [the reference] disclosed the identical function. [Emphasis added, citation omitted.]

Furthermore, Shoda describes a second embodiment that includes displays such as those depicted in Figures 13a, 13b, 14a, and 14b. Applicants again submit that this

embodiment also does not teach or suggest the above-noted features of the above-noted independent claims.

With respect to Figure 13a and 13b, Applicants also again note that this display is a display screen (72) of the data processing apparatus (2). The sub-screen (73) indicates contents stored in the data processing apparatus (2) and sub-screen (74) indicates contents in the external storage medium (7). (Col. 11, lines 52-54.) However, the *display screen (72) of the apparatus (2)* does not indicate a track that was not previously recorded *on the apparatus* as being selected for recording, in the manners recited in the independent claims. Note that AAAAAA and BBBB are stored on the apparatus (2), as is evident from the icons indicating various rights (or lack thereof) associated with each such content. Further, note that PPPPP and QQQQQ are not stored on the apparatus (2), and yet are not indicated as being selected for recording to the apparatus (2). In fact, Figures 14a and 14b depict a situation in which PPPPP and QQQQQ are prevented from being transferred to the apparatus (2), since the content did not originate from the apparatus, which is clearly contrary to the present invention.

Furthermore, these observations as to Figure 13a and 13b of Shoda are clearly not acknowledgements that Shoda teaches or suggests some reason for determining which tracks have been previously recorded, where such a reason is well established to be required as the necessary rational underpinning noted above as to the *Kahn* decision and MPEP § 2141. The PTO attempt to suggest that Shoda is, in some completely unexplained manner, “capable of determining which tracks have been previously recorded [i.e. “ripped”] onto the apparatus,” in the sentence bridging pages 3 and 4 and at the bottom of pages 5 and 7 of the outstanding Action is nothing more than an unsupported conclusion of a capability by the PTO. Simply because something is asserted to be capable of being modified to perform as claimed, this is a far cry from the requirement for the PTO to establish a reasonable and/or logical basis for the

suggested modification. *See In re Regel*, 526 F.2d 1399, 1403 n.6, 188 USPQ 136, 139 n.6 (CCPA 1975) (“[T]here must be some logical reason apparent from positive, concrete evidence of record which justifies a combination of primary and second references”).

Similarly, the undocumented conclusion that “iTunes is also capable of discerning and remembering which track has already been recorded” is a mere conclusion, not the required “logical reason apparent from positive, concrete evidence of record.”

Not only does the outstanding Action repeatedly rely on improper mere conclusions as to the above-noted mere assertions as to capabilities, it also lacks any line of reasoning as to why the artisan viewing only the collected teachings of the references would have found it obvious to selectively pick and choose various user interface concepts from the several references relied on and to further modify them as to the above noted mere conclusions to arrive at the claimed invention. This approach violates the precedent of the PTO itself. *See Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985) as follows:

Presuming *arguendo* that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collected teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the examiner has done little more than cite references to show that one or more elements, or some combinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements, but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Further note *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998):

If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed

elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

Thus, Applicants submit that Shoda combined in any proper manner with Robbin and the "iBasics references" fails to teach or reasonably suggest the limitations of independent Claims 1, 3, 4, 14, 18, and 19 of the present application. Accordingly, Applicants respectfully request the withdrawal of the rejection of these independent claims over Shoda taken with Robbin and the "iBasics references" under 35 U.S.C. 103(a).

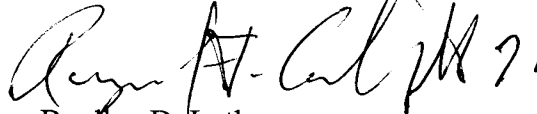
Dependent Claims 2, 5-13, 15, 17, 19, 21, 23, 25-28, 30, 32, and 34 are considered allowable for the reasons advanced for the respective independent claim from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of their respective independent claim.

Application No. 09/975,827
Reply to Office Action of 01/22/2008

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'Bradley D. Lytle', is written over the printed name.

Bradley D. Lytle
Registration No. 40,073
Attorney of Record

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

BDL:RFC:jmp

Raymond F. Cardillo, Jr.
Registration No. 40,440

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